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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,238	02/11/2002	Hans-Jurgen Brehm	MERCK-2387	9123

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EXAMINER	
SHOSHO, CALLIE E	

ART UNIT	PAPER NUMBER
1714	

DATE MAILED: 09/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/071,238	BREHM ET AL.	
	Examiner	Art Unit	
	Callie E. Shosho	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-20 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) ~~Paper No(s).~~ 6/10/02 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(a) Claims 1 and 19 each disclose that the pigment has "predominantly" two-dimensional shape. The scope of the claims is confusing because it is not clear what is meant by "predominantly". When is a pigment considered to have a "predominantly" two-dimensional shape? Clarification is requested.

(b) Claims 1 and 19 each disclose that the filler has "substantially" isometric body shape. The scope of the claims is confusing because it is not clear what is meant by "substantially" or when the filler is considered to have "substantially" isometric body shape. Clarification is requested.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-9 and 11-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Solms et al. (U.S. 6,545,065).

Solms et al. disclose plastic part comprising lustrous pigment, solid filler, and assistant for plastic processing. The lustrous pigment is pearl luster pigment such as titanium dioxide or iron oxide coated mica which has particle size of, for instance, 5-20 μm. The solid filler has particle size of 1-150 μm and includes glass. The plastic is transparent thermoplastic plastic. The plastic contains 0.5-10% mixture of lustrous pigment and solid filler wherein the mixture contains 1 part lustrous pigment and 1-10 parts filler. Thus, it is calculated that the plastic part comprises approximately 0.25-9% filler. It is also disclosed that the plastic part is made by incorporating the lustrous pigment and filler into the plastic and that the plastic part is made by injection molding (col.1, lines 3-7, col.2, lines 23-27, 31-39, and 47-64, col.3, lines 1-11 and 18-22, and col.4, line 14).

Although there is no disclosure that the alignment of the lustrous pigment is other than substantially parallel with the surface of the plastic part, given that the pigment is mixed with filler identical to that presently claimed whose presence would affect the alignment of the pigment, it is clear that the alignment of the lustrous pigment would inherently be other than substantially parallel with the surface.

Further, although there is no disclosure that the plastic part exhibits pronounced glitter effect, given that Solms et al. disclose lustrous pigment and filler identical to that presently claimed, it is clear that the plastic part would inherently possess glitter effect as presently claimed.

In light of the above, it is clear that Solms et al. anticipate the present claims.

5. Claims 1-14 and 17-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Griessmann et al. (U.S. 6,544,327).

Griessmann et al. disclose plastic part comprising lustrous pigment, hollow filler, and assistant for plastic processing. The luster pigment is titanium dioxide coated silica or iron oxide which has particle size of, for instance, 5-25 μm. The solid filler has particle size of 0.05-150 μm and includes hollow glass. The plastic part comprises 0.1-10% filler. It is also disclosed that the plastic part is made by incorporating the lustrous pigment and filler into the plastic (col.2, lines 5-14 and 32-58, col.3, lines 59-67, col.5, lines 7-14, col.6, lines 28-30, col.7, line 38, and col.8, lines 5-10).

Although there is no disclosure that the alignment of the lustrous pigment is other than substantially parallel with the surface of the plastic part, given that the pigment is mixed with filler identical to that presently claimed whose presence would affect the alignment of the pigment, it is clear that the alignment of the lustrous pigment would inherently be other than substantially parallel with the surface.

Further, although there is no disclosure that the plastic part exhibits pronounced glitter effect, given that Griessmann et al. disclose lustrous pigment and filler identical to that presently

claimed, it is clear that the plastic part would inherently possess glitter effect as presently claimed.

In light of the above, it is clear that Griessmann et al. anticipate the present claims.

6. Claims 1-3, 11, and 14-20 rejected under 35 U.S.C. 102(b) as being anticipated by Ittmann et al. (U.S. 5,882,560).

Ittmann et al. disclose plastic part comprising lustrous pigment, solid filler, and assistant for plastic processing. The luster pigment has particle size of 20-500 μm. The solid filler has particle size of less than 100 μm. The plastic is transparent thermoplastic plastic. It is also disclosed that the plastic part is made by incorporating the lustrous pigment and filler into the plastic (col.1, lines 10-13, col.2, lines 7-21, col.3, lines 6-59, and col.5, lines 14-24).

Although there is no disclosure that the alignment of the lustrous pigment is other than substantially parallel with the surface of the plastic part, given that the pigment is mixed with filler identical to that presently claimed whose presence would affect the alignment of the pigment, it is clear that the alignment of the lustrous pigment would inherently be other than substantially parallel with the surface.

Further, although there is no disclosure that the plastic part exhibits pronounced glitter effect, given that Ittmann et al. disclose lustrous pigment and filler identical to that presently claimed, it is clear that the plastic part would inherently possess glitter effect as presently claimed.

In light of the above, it is clear that Ittmann et al. anticipate the present claims.

7. Claims 1, 4-7, 10, 12-14, and 17-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Schoen et al. (U.S. 6,488,756).

Schoen et al. disclose plastic part comprising lustrous pigment, solid filler, and assistant for plastic processing. The lustrous pigment is silica coated with metal or metal oxide which has particle size of, for instance, 10-60 μm. The solid filler has particle size of 0.001-10 μm. The plastic part exhibits glittering effect. The plastic contains 0.1-50% mixture of lustrous pigment and solid filler wherein the mixture contains lustrous pigment and filler in ratio of 1:2 to 2:1. Thus, it is calculated that the plastic part comprises approximately 0.003-9% filler. It is also disclosed that the plastic part is made by incorporating the lustrous pigment and filler into the plastic and that the plastic part is made by injection molding (col.1, lines 5-11 an 55-58, col.1, line 59-col.2, line 3, col.2, lines 21-26, 44-57, and 63, col.3, lines 5-9 and 24-28, and col.5, line 1).

Although there is no disclosure that the alignment of the lustrous pigment is other than substantially parallel with the surface of the plastic part, given that the pigment is mixed with filler identical to that presently claimed whose presence would affect the alignment of the pigment, it is clear that the alignment of the lustrous pigment would inherently be other than substantially parallel with the surface.

In light of the above, it is clear that Schoen et al. anticipate the present claims.

8. **NOTE:** It is noted that there is no disclosure in either Griessmann et al. (U.S. 6,544,327) or Ittmann et al. (U.S. 5,882,560) that the plastic part is made by injection molding as required in

present claim 20. However, "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself". See MPEP 2113.

Thus, although neither Griessmann et al. nor Ittmann et al. disclose injection molding as claimed, it is noted that "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) . Further, "although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product" In re Marosi, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983).

Therefore, absent evidence of criticality regarding the presently claimed injection molding process and given that the cited references meet the requirements of the claimed plastic part, Griessmann et al. and Ittmann et al. clearly meet the requirements of present claim 20.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griessmann et al. (U.S. 6,544,327) or Schoen et al. (U.S. 6,488,756).

The disclosures with respect to Griessmann et al. and Schoen et al. in paragraphs 5 and 7 above are incorporated here by reference.

The difference between Griessmann et al. or Schoen et al. and the present claimed invention is the requirement in the claims of specific type of plastic.

Both Griessmann et al. and Schoen et al. disclose adding lustrous pigment and filler to plastics, but there is no explicit disclosure of specific type of plastics utilized.

However, the broad disclosure of plastics clearly encompasses transparent thermoplastic plastics as presently claimed. Thus, it would have been within the skill level of, as well as obvious to one of ordinary skill in the art to choose plastic, including transparent thermoplastic as presently claimed, depending on the end use and desired appearance of the plastic part, and thereby arrive at the claimed invention.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gubitz et al. (U.S. 5,208,081) disclose plastic molding comprising lustrous pigment and filler, however, there is no disclosure of the particle size of the filler as presently claimed.

Gutman et al. (U.S. 3,382,201) disclose molded resin comprising pearlescent pigment, however, there is no disclosure of filler presently claimed.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Callie Shosho

Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
9/13/03